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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,836	09/17/2003	Zhi-Xian Wang	PT-2050000	2694

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EXAMINER

OH, TAYLOR V

ART UNIT PAPER NUMBER

1625

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/663,836

Applicant(s)

WANG ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3/MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-8 and 10-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-8,10-23,25,26 and 35 is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Final Rejection***

#### **The Status of Claims**

Claims 1-2 , 4-8, 10-23, 25-26, and 27-35 are pending.

Claims 27-34 have been rejected.

Claim 1-2 , 4-8, 10-23, 25-26, and 35 are allowable.

#### **Specification**

The objection of the disclosure has been withdrawn due to the modification made in the specification.

#### **Claim Objections**

The objection of Claim 4 has been withdrawn due to the modification of the claim.

However, there is another issue involved in claim 27.

Claim 27 is objected to because of the following informalities:

In Claim 27, the new phrase "and wherein R<sup>2</sup> is not 2,2,2-trifluoroethyl or cynomethyl groups ;" is introduced.

However, the newly introduced phrase "and wherein R<sup>2</sup> is not 2,2,2-trifluoroethyl or cynomethyl groups" are not present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support

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the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 4-8, 11-23, and 26 under 35 U.S.C. 112, first paragraph, has been withdrawn due to the modification of the claims. However, there is another issue involved in claim 27.

Claim 27 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 27, the new phrase "and wherein R<sup>2</sup> is not 2,2,2-trifluoroethyl or cynomethyl groups ;" is introduced. However, the newly introduced phrase "and wherein R<sup>2</sup> is not 2,2,2-trifluoroethyl or cynomethyl groups" are not present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes.

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New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification of the claims.

The rejection of Claims 8-10, 23-25, and 28-30 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification of the claims.

### ***Claim Rejections - 35 USC § 102***

1. Applicants' argument filed 3/1/06 have been fully considered but they are not persuasive.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 27-29, 31, and 33-34 under 35 U.S.C. 102(b) as being anticipated clearly by Mcdaniel et al (WO 02/066413) is maintained for the reasons of the record on 12/01/05.

The rejection of Claims 27-28, and 31 under 35 U.S.C. 102(b) as being anticipated clearly by Banitt et al (US 4,005,209) is maintained for the reasons of the record on 12/01/05.

### **Claim Rejections-35 USC 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**The rejection of Claims 27-34 under 35 U.S.C. 103(a) as being unpatentable over Mcdaniel et al (WO 02/066413) in view of Banitt et al (US 4,005,209).**

The rejection of Claims 27-34 under 35 U.S.C. 103(a) as being unpatentable over Mcdaniel et al (WO 02/066413) in view of Banitt et al (US 4,005,209) has been maintained for the reasons of the record on 12/01/05.

### **Applicants' Argument**

The applicants argue in the followings :

1. applicant has amended claims 27-29,31, and 33-34 to exclude any embodiments where the alkyl group is 2,2,2-trifluoroethyl or cynomethyl groups; therefore, the rejection under 35 USC 102 (b) needs to be reconsidered;
2. the rejection of Claims 27-34 under 35 U.S.C. 103(a) as being unpatentable over Mcdaniel et al (WO 02/066413) in view of Banitt et al (US 4,005,209) is improper since applicant has amended claims 27-29,31, and 33-34 to exclude any embodiments where the alkyl group is 2,2,2-trifluoroethyl or cynomethyl groups;
3. There is no reasonable success for the process as claimed 27-34 by substituting simple esters as shown in March's Advanced Organic chemistry.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with respect to the first and second arguments, the Examiner has noted applicants' argument. However, the newly introduced phrase "and wherein

R<sup>2</sup> is not 2,2,2-trifluoroethyl or cynomethyl groups " are not present and shown in the original specification. A close inspection of the original claims and specification do not provide antecedent basis for the proposed changes. New matter can not be introduced into specification at any time during the prosecution, unless there is a supporting description that would support the proposed changes. Applicant is required to cancel the new matter in the reply to this Office Action.

Second, with respect to the third argument, the Examiner has noted applicants' argument. However, the applicants' argument is unrelated to the issue because of the following: what is concerned in the reaction is not the reactant substituted by the methyl or ethyl, but the use of toluene solvent in the claimed process. Banitt et al does teach that it is possible to use the benzene solvent similar to the toluene for the process ; they are commonly known as hydrocarbon solvents; they have shared a similar physical and chemical property due to being a homologue to each other. Furthermore, it is well-established that the substitution of methyl for hydrogen on known compound is not a patentable modification absent unexpected or unobvious results. In re Wood, 582 F. 2d 638, 199 USPQ 137 (C.C.P.A. 1978); In re Hoke, 560 F.2d 436, 195 USPQ 148 (C.C.P.A. 1978). Therefore, it would have been obvious to the skilled artisan in the art to be motivated to use the toluene solvent as an alternative to the benzene. This is because the skilled artisan in the art would expect such a modification to be successful in the absence of unexpected or unobvious results. Therefore, applicants argument is irrelevant to the issue of the invention.



### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\* *Myles* ✓ *02*  
*5/14/06*